

REMARKS/ARGUMENTS

Claims 1, 7-40, 76-79 and 82 are pending in this application.

Claim Rejections - 35 U.S.C. § 103(a)

In the Non-Final Office Action mailed December 28, 2009, the Examiner rejected claims 1, 7-40, 76-79, and 82 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,022,316 (hereinafter, “the ‘316 patent”) in view of U.S. Patent No. 6,692,456 (hereinafter, “the ‘456 patent”). Applicants respectfully traverse the rejection.

The Examiner states that the ‘316 patent discloses a method of delivering drugs through and/or withdrawing fluids from a biological membrane comprising the steps of applying at least one heated probe element capable of delivering thermal energy to cause ablation of the membrane to form a plurality of openings wherein the depth of the micropores preferably ranges from 40-180 microns. The Examiner acknowledges that the ‘316 patent does not specifically teach an opening depth of the majority of the delivering openings falls within a range of about 40 to about 90 microns or that the delivery openings have a distribution resulting in a bell-shaped curve with the delivery openings having a mean opening depth of between about 40 and 90 microns. However, the Examiner states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the openings with the recited distribution, since it has been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, citing *In re Aller*, 105 USPQ 233 (CCPA 1995), in the paragraph bridging pages 3-4 in the Office Action.

The Examiner also notes that the ‘316 patent does not recite the use of a delivery patch. The Examiner alleges that ‘456 patent discloses a method of delivering drugs through created micropores by placing a patch on the openings. Therefore, the Examiner alleges it would have been obvious to one of skill in the art to modify the method of the ‘316 patent to include a step of patch drug delivery as disclosed by the ‘456 patent.

Applicants respectfully traversed this same rejection in their October 1, 2009 reply. In response to Applicants’ comments, the Examiner now states that “the breadth of the claims does

not prohibit electroporation from being used in combination with the heated probe” (page 4, Office Action).

Solely in the interest of promoting prosecution, Applicants hereby amend claims 1 and 21 to recite particular methods for characterizing the depth. Support for the amendments may be found, at least, in paragraphs [0045], [0047], [0049], and [0050] of the published application. No new matter has been added by way of these amendments. Applicants respectfully submit that these means for characterizing the depth are neither taught nor suggested in either the ‘316 patent or the ‘456 patent and as such would not be obvious to one skilled in the art considering the references alone or in combination. Applicants respectfully request withdrawal of the rejection.

CONCLUSION

The foregoing is submitted as a full and complete response to the Non-Final Office Action mailed December 28, 2009, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application that may be corrected by Examiner’s amendment, or there are any other issues which can be resolved by telephone interview, please call the undersigned agent at (404) 572-2473.

Applicants submit that no additional fees beyond those required for an Extension of Time are required for submission of this paper. However, the Commissioner is hereby authorized to charge any fee deemed necessary for consideration of this paper, and to credit any overpayment, to Deposit Account No. 11-0980.

Respectfully submitted,

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